



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/284,699 | 04/19/1999 | YASUSHI TANAKA | 450108-4542 | 2687 |

20999 7590 09/10/2002

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2611

DATE MAILED: 09/10/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,699

Applicant(s)

TANAKA, YASUSHI

Examiner

Jason P Salce

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 01 February 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on 8/2/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/284,699 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Objections

Claims 1,6,16, and 22 are objected to because of the following informalities: In the newly added limitations "at least address information designating a further detailed information" should be rewritten to "at least address information designating further detailed information" for clarity. Appropriate correction is required.

Response to Arguments

Applicant's arguments filed 8/02/02 have been fully considered but they are not persuasive.

Applicant argues that Schein does not disclose "When a cursor is moved over a program column of the program guide screen, further detailed information is transmitted in accordance with the commercial". The examiner notes that this limitation was covered in the previous office action.

Applicant further argues that "Schein describes either having all the information available on-line, or transmitting all of the information in a database up front". The examiner states that this argument is not disclosed in the applicants claim limitations. Applicant states that when a cursor is moved over a program column that more detailed information is transmitted, but does not distinguish whether or not the

Art Unit: 2611

data is transmitted automatically when the cursor is stagnant on the program column or if a user input is initiated, therefore, applicants argument will not be addressed.

Applicant also argues that Schein does not disclose "the transmission of some commercial data, including an address location of the further detailed information, with the program guide, and then retrieving the further detailed information corresponding to the address information when desired by designation of a cursor rolling-over a predesignated location". Again, the examiner states that the applicant does not claim that simply scrolling over a program column initiates the transmission of detailed information, and that the applicant does not distinguish whether or not the data is transmitted automatically when the cursor is stagnant on the program column or if a user input is initiated, therefore, applicants argument will not be addressed.

Examiner also notes that the only limitation added to the claims are to accentuate that the commercial information also comprises address information designating a location of further detailed information corresponding to the commercial information. Therefore, the examiner repeats his rejection and further explains how the newly added limitations are covered by the Schein reference.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al. (U.S. Patent No. 6,002,394).

Referring to claim 1, Schein discloses transmitting program guide information together with a broadcasting program (Column 12, Lines 20-24). Schein also discloses commercial information that corresponds to program guide information (Column 20, Lines 51-54), which is displayed on a program guide screen in a receiver (Column 8, Lines 35-43) is transmitted with program guide information (see transmitting a advertisement database in Column 12, Lines 28-29 and Column 7, Lines 65-67).

Schein also discloses transmitting additional commercial information when a cursor is moved onto a program column of said program guide screen (Column 24, Lines 1-20 and Figures 21A-21F). The examiner refers applicant to the arguments above to again stress that no distinction is made whether the cursor is being actuated or not on the program guide in order to transmit the data when the cursor lies on the program column. Addressing the newly added limitation of the **"commercial information comprising at least address information designating a location of further detailed information corresponding to said commercial information"**, Schein clearly shows at Column 17,

Lines 57-67 and Column 18, Lines 1-6 and 39-43 and 59-67 that when requesting more detailed information the user can access a website (which includes address information), and that the website can link users to additional information relating to the commercial information. This clearly shows a relation between the commercial data ("Associated Products" at Column 17, Line 66), which contains address information (URL discussed at Column 18, Lines 39-43) which will direct the user to more detailed information (Column 17, Lines 66-67 and Column 18, Lines 1-6).

Referring to claim 2, Schein discloses that the commercial information contains image data (Column 11, Lines 56-57).

Referring to claim 3, Schein discloses that a digital signal can have separate bitstreams that contain video, audio, and program guide information (Column 6, Lines 51-60), and that data related to a television program guide title is related to an advertisement (Column 26, see Claim 14).

Referring to claim 4, Schein discloses that commercial information can be accessed on a remote computer via the Internet (Column 20, Lines 4-9), and that a computer on a computer network (Internet) can be given an IP address (Column 18, Lines 20-43).

Referring to claim 5, Schein discloses hierarchical levels for program schedule data (Column 9, Lines 20-67 and Column 10, Lines 1-28) for a program guide, which contains advertisements (Column 22, 10-18). Schein shows that a first hierarchical level (Channel Data Table) is smaller by holding only the channel required for viewing at a specific subscriber's receiver, while the second hierarchical level (show list) contains

start times and additional scheduling data for 24 hours worth of program for every channel listed in the Channel Data Table (Column 9, Lines 20-62 and Figures 5 and 6). It is inherent that the Channel Data Table is smaller than the Show List Table because of the large amount of data storage that would be required to hold 24 hours or weeks worth of show times for each program contained in the Channel Data Table.

Referring to claim 6, Schein discloses a receiver for separating program guide information from a received broadcasting signal (Column 12, Lines 41-44). Schein also discloses displaying commercial information in a part of a display area (see Figure 21A and Column 24, Lines 1-20), and an electronic program guide screen including program columns corresponding to a plurality of programs based on the separated program guide information (see Figure 21A). Schein also discloses when a cursor is moved onto one program column that plural items of commercial information are sequentially displayed on a program guide (Figure 21C and Column 24, Lines 1-20). Please refer to claim 1 for the discussion of how the newly added limitations, relating to the commercial information comprising address information, which is disclosed by Schein.

Referring to claim 7, Schein discloses communicating with an external computer through a computer network (Column 20, Lines 4-9). Schein also discloses displaying further detailed information from an external computer based on address information to display the information when a cursor is moved onto one of the program columns (Figures 21B and 21C and Column 18, Lines 20-43 and Column 19, Lines 51-63).

Referring to claim 8, Schein discloses selecting a program column on a program guide, and displaying program details corresponding to the program column selected

and to sequentially display plural items of commercial information included in the program in a part of the display area (see Figures 21A, 21B, and 21C and Column 24, Lines 1-19).

Referring to claim 9, Schein discloses displaying a commercial details screen (see top left window explaining NFL cap in Figure 21C).

Referring to claim 10, see rejection of claim 9.

Referring to claim 11, Schein discloses sponsors for presenting commercial information (Column 22, Lines 10-18).

Referring to claim 12, Schein discloses an address of a computer on a computer network, which provides detailed information of a commercial (Column 20, Lines 1-17 and Column 18, Lines 20-43).

Referring to claim 13, Schein discloses communicating with an external computer on a computer network (Column 20, Lines 4-9). Schein also discloses extracting the detailed information of the sponsor's commercial from the external computer by using the address information of the computer (Column 18, Lines 20-43 and Column 20, Lines 51-54).

Referring to claim 14, see rejection of claim 2.

Referring to claim 15, see rejection of claim 3.

Referring to claim 16, see rejection of claim 6.

Referring to claims 17-21, see rejections of claims 8-12, respectively.

Referring to claim 22, see rejection of claim 16.

Referring to claims 23-24, see rejection of claims 20-21, respectively.

Art Unit: 2611

Referring to claims 25-26, see rejection of claims 25-26, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-9048.

September 5, 2002



Bhavesh Mehta
Primary Examiner